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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,397	09/18/2001	Jaime A. Siegel	SNY-R4757	1207
24337	7590	08/16/2006	EXAMINER	
MILLER PATENT SERVICES 2500 DOCKERY LANE RALEIGH, NC 27606			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,397

Applicant(s)

SIEGEL ET AL.

Examiner

James A. Reagan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-102 is/are pending in the application.
- 4a) Of the above claim(s) 1-93 and 102 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 93-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the response filed on 05 June 2006.
2. Claims 94-101 have been elected.
3. Claims 1-93 and 102 are withdrawn from consideration
4. Claims 94-101 are currently pending and have been examined.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 94-101 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Stefik et al. (US 5,629,980 A).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or

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part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claims 84 and 94:

Stefik discloses the following limitations:

- *a programmed processor (see at least column 4, lines 6-10);*
- *a mass storage device storing a selection of A/V content, the A/V content comprising at least an audio portion, a video portion and a table of contents (TOC) file indexing a selected one of the audio and video portions (see at least column 4, lines 6-10; column 3, lines 52-56);*
- *program means, running on the programmed processor, for:*
- *presenting a customer with an opportunity to complete a transaction to acquire rights to the selected one of the audio and video portions indexed by the TOC (see at least Figure 15 as well as associated text); and*
- *enabling the customer to store the selected portion (see at least column 4, lines 6-13).*

Claims 85 and 95:

With regard to the limitation of *the A/V content is stored as one or more digital files*, see at least column 4, lines 6-10; column 3, lines 52-56.

Claim 86:

With regard to the limitation of *the TOC is stored as one or more digital files*, see at least column 4, lines 6-10; column 3, lines 52-56.

Claims 87 and 96:

With regard to the limitations of:

- *sending the customer a key code to permit the customer to store one or more digital files containing the selected portion;*
- *receiving a key code and using the key code to store one or more digital files*
- *containing the selected portion;*

See at least Figure 17 as well as associated text.

Claims 88 and 97:

With regard to the limitations of:

- *receiving a payment from the customer;*
- *permitting the customer to store the selected portion in accordance with a usage rule;*
- *sending a payment;*
- *storing the selected portion in accordance with a usage rule.*

See at least Figures 3, 15, 17, 18, and 19, as well as associated text.

Claims 89 and 98:

With regard to the limitation of *the usage rule determines a number of copies of the selected portion that can be made*, see at least Figures 15, and 18, as well as associated text.

Claims 90 and 99:

With regard to the limitation of *presenting a menu to the customer upon activation of the digital form of the A/V content, with the menu having a menu selection for purchasing the selected portion*, see at least column 9, lines 2-5.

Claims 91 and 100:

With regard to the limitations of:

- *means for transferring the A/V content to the customer;*
- *means for receiving the selected portion from a content provider;.*

See at least column 1, line 28.

Claims 92 and 101:

With regard to the limitation of *the means for transferring comprises one of means for downloading the A/V content as one or more digital files, means for streaming the A/V content, and means for transmitting the A/V content as a real time transmission*, see at least column 2, line 38.

Claim 93:

With regard to the limitation of *the transaction comprises one of a purchase of unlimited rights to play the selected portion, a purchase of rights to play the selected portion for a designated period of time, and a purchase of rights to play the selected portion a designated number of times*, see at least Figure 15 as well as associated text.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

571-273-8300 [Official communications, After Final communications labeled "Box AF"]

571-273-8300 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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401 Dulany Street

Alexandria, VA 22314.

JAMES A. REAGAN

Primary Examiner

Art Unit 3621

15 August 2006

JAMES A. REAGAN
PRIMARY EXAMINER

